

REMARKS

No claims have been amended, cancelled or added in this Reply. Accordingly, claims 40-54 are currently pending.

Restriction Requirement

Applicants remind the Examiner of his desire to address the Restriction Requirement with his SPE after addressing the pending rejections. As explained below, Applicants have addressed the outstanding rejections (even as these rejections might be applied to provisionally withdrawn claims) and request the Examiner provide his SPE with Applicant's previous remarks regarding the traversed Restriction Requirement. *See* Response to Non-Final Office Action dated 15 September 2009 (filed 15 January 2010).

Double Patenting Rejection

The Examiner has rejected claims 40-47 and 52-53 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-43 of U.S. Patent No. 6,721,411. Office Action dated 29 September at p. 3. A terminal disclaimer in compliance with 37 C.F.R. 1.321 has been filed herewith. Accordingly, Applicants respectfully request the Examiner withdraw this rejection.

Rejections under 35 U.S.C. § 112, 2nd ¶

The Examiner has rejected Claims 40-47 and 52-53 under 35 U.S.C. 2nd ¶ as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As a preliminary matter, Applicants feel it is improper for the Examiner to be raising this issue at this time because the claims have stated "if and only if" since a preliminary amendment filed on 20 August 2004. Raising issues of this sort after three separate Office Actions on the merits is counter to the principle of compact prosecution desired by the USPTO (M.P.E.P. 707.07(g), 37 C.F.R. 1.104(a)(1)). The phrase "if and only if" could not be more definite and certainly should not be rejected based on the word "if" as it appears the Examiner has done here.

The Examiner is reminded "[i]n reviewing a claim for compliance under 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice

function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.” M.P.E.P. § 2173.02.

In particular the Examiner asserts:

The “if” statements contained in the independent claims render the claims indefinite because it is unclear whether the limitations following the “if” statements are part of the claimed invention. For example, in claim 1, it is possible that no noise was determined or present. If so, in a prior art rejection, all that needs to be found is a reference that determines whether noise is present on at least one port.

Office Action dated 29 September 2010 at p. 2.

However, when claim 40¹ is properly interpreted as a whole it is clear that the claim apprises one of ordinary skill of its scope as required. What the Examiner calls an “if” statement is attached to a limitation of “determining a dynamic threshold value for the at least one port” and is more than a simple if statement, but one that causes the determination “*only if*” noise was found to be present. Each of the subsequent limitations of “comparing” and “including” are expressly tied to a comparison of the “determined dynamic threshold value” and thus are only applicable when noise was present. The claims must be interpreted as a whole. Applicants submit that when the claims are properly interpreted as a whole and in light of the Specification claim 40 clearly meets the requirements of 35 U.S.C. 112, second paragraph.

Furthermore, the claim states “if, and only if” rather than just “if.” The phrase “if, and only if” as recited in the claim is not an “if statement” but is more of a qualifier (e.g., like the word “when”). The Examiner’s contention that “it is possible that no noise was determined or present. If so, in a prior art rejection, all that needs to be found is a reference that determines whether noise is present on at least one port” is wholly unfounded. The case where no noise is found is irrelevant to the limitations recited in claim 40 because each limitation of “determining, comparing and including” require noise to have been present on the at least one port. Based on these remarks, Applicants respectfully request the Examiner withdraw this rejection.

The Examiner also maintains the 112 rejections pertaining to terms outlined in the Office Action dated 04/14/2010 and requests update to the Specification. Applicants have amended the Specification to address the Examiner’s request. Accordingly, Applicants respectfully request

¹ The Examiner refers to claim 1 but clearly intends to refer to claim 40 in this section of the rejection.

the Examiner withdraw the maintained 112 rejections.

As a final matter, it is improper for the Examiner to assert:

Because of the indefinite problems noted above a proper search could not be conducted at this time.

Office Action dated 29 September 2010 at p. 2.

The Examiner has already performed at least three (3) searches on substantially the same claims (Jan 2008, Dec 2008, and Sep 2009) and is only now raising an issue of an “if and only if” definitive statement recited in claim 40, which was added by preliminary amendment in August 2004. Independent claim 52 mirrors the language of independent claim 40. Independent claims 46 and 53 expressly tie an act of omitting to a positive condition if statement and thus have no indefiniteness issues. For all the reasons stated above, Applicants respectfully request the Examiner withdraw all outstanding 35 U.S.C. 112 second paragraph rejections.

Conclusion

This paper is intended to be a complete response to the above identified Office Action. Applicants believe no fees are due with this Response. However, should any other fees be due, the Office is authorized to deduct this fee and any such other fees from Deposit Account no. 501922 referencing attorney docket number 199-0239US-C. Applicants invite the Examiner to call the undersigned with respect to any questions pertaining to this Response or associated application (832/446-2445).

Respectfully submitted,

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